

REMARKS

Claim Rejections Under 35 U.S.C §102

U.S. Patent No. 6,136,130 (Tataryan, et al.) does not anticipate the present invention because it fails to teach or suggest one or more fold lines including a discontinuous line of microperforations with ties between the microperforations and intermittent non-perforated sections. Rather, Tataryan, et al. discloses a fold line comprised of "cuts and ties". (See claim 1, column 4, and lines 1-3, and column 4, lines 34-37). The language referred to at lines 47-57 of column 4 refers to varying the specific dimension and size of "the cuts and ties for perforations." There is no indication anywhere in this reference of a discontinuous line of microperforations (with ties between them) spaced with intermittent nonperforated portions as claimed herein.

In response to applicant's last reply of August 18, 2003 (which is incorporated by reference in the present reply), the action alleges that Tataryan, et al. at Fig. 1, reference numeral 24 discloses a noncontinuous line of perforations with intermittent non-perforated areas. To support that interpretation, the action cites the case *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ 2d 1664, 1667 (Fed. Cir. 2000) for the assertion that claims must be given their broadest reasonable interpretation consistent with the specification. Emphasis added. Following that rationale, the action asserts that there are no limitations in the claim stating that the non-perforated portions and the ties have the same [*sic*: different] length between individual perforations, therefore the printable sheet of Tataryan, et al. with its perforations read upon the claimed article.

In re Hyatt dealt, in part, with a sharing system for applications such as illumination systems comprising a sharing generator. The sharing system compensated for a defect in one display device by using the surrounding display devices to generate intensity that was supposed to be generated by the defective device. On appeal, the appellant argued that the term "shared" meant that illumination intensity display signals must be received by more than one display device at the same time. The Office interpreted the term "shared" to require only that the intensity signal be available to more than one of the correction circuits, even if only one of the correction circuits transmits the signal to its corresponding display device. The Federal Circuit held that the specification contained no definition

of “shared” or “sharing” that would require the Board to construe those limitations in the narrower manner asserted by the Appellant.

In the present case, applicant’s specification discloses that the conventional fold of microperforations weakens substrates too much to provide fold lines. See specification, page 1, lines 19-20. The present invention solves this deficiency by providing a discontinuous line of both microperforations separated by non-perforated sections. See specification, page 2, lines 1-4. The microperforations do not extend across the whole length of the fold line. The fold line is shared with intermittent non-perforated sections. See specification, page 3, lines 11-12. The ties between the microperforations are preferably less than 0.5 mm in length and most preferably in the range of 0.2 mm to 0.4 mm (specification, p. 3, lines 3-4), while the intermittent non-perforated sections preferably vary in length from about 1 mm to 5 mm, preferably about 2.5 mm.

Consequently, unlike the facts in *In re Hyatt*, the present specification provides that the intermittent non-perforated sections have a length greater than the ties to increase the strength of a substrate along a fold line. However, the action’s interpretation of the ties and non-perforated sections having the same length is inconsistent with the disclosure of the present specification. See particularly, new claims 20 and 21. Applicant respectfully submits that these claims do not raise new issues because their features are depicted in e.g., claims 8 and 11.

Consequently, the disclosure of cuts and ties in Tataryan, et al. is insufficient to anticipate the present invention.

Claim Rejections Under 35 U.S.C §103

Popat, et. al. (U.S. Patent No. 5,662,976) discloses a laminated card assembly which employs microperforations to enable the separation of sections. (See column 3, lines 30-34). Popat, et. al. does not disclose employing microperforations to provide a fold line for a printable substrate. Popat, et al. does disclose the use of perforations in fold lines (82) for a lamination strip. However,

- 1) there is no indication these perforations can comprise microperforations,
- 2) there is no indication that the perforations can be discontinuous with both ties and intermittent non-perforated areas ,
- 3) there is no indication that the lamination strip can be unfolded once folded, and

- 4) there is no indication the lamination strip can receive print.

Therefore, the teachings of Popat, et. al. add nothing to those of Tataryan, et al. to show or suggest the use of discontinuous microperforations to provide a fold line. Therefore, none of the pending claims (claims 1-19), are obvious in view of the combined teachings of Tataryan, et al. and Popat, et. al.

Janssen

Janssen (U.S. Patent No. 3,547,752) describes the use of weakened lines within a substrate to permit the sheet to conform to a curved platen such as a roller. There is no hint or suggestion how to weaken a substrate with discontinuous microperforations and both ties and intermittent non-perforated areas. The configuration of Janssen uniformly weakens the substrate for separation and bending and does not provide for a preferred location of a fold line. Therefore, the teachings of Janssen add nothing to those of Tataryan, et. al. or Popat, et. al. to render the claims herein obvious.

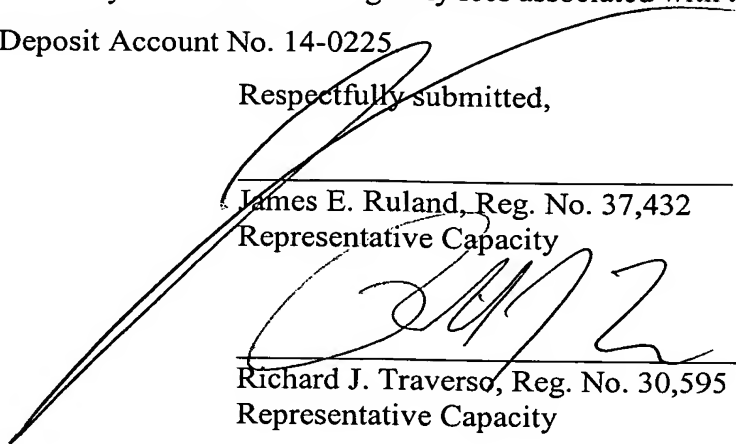
Furthermore, there is no motivation to locate non perforated sections to be in-line where the feed rollers engage the substrate. Applicant traverses the assertion that this feature is subject to a product-by-process interpretation. Rather, this feature structurally defines the substrate.

The combined teachings of the cited references show nothing more than the use of microperforations. The combined teachings of the cited references provide no motivation to form a discontinuous line of microperforations with both ties and intermittent portions of non-perforated areas.

Based on the above remarks, Applicants submit claims 1-21 are in a form suitable for allowance and patentable over the cited references. Therefore, withdrawal of the rejections and allowance of these claims are earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 14-0225

Respectfully submitted,



James E. Ruland, Reg. No. 37,432
Representative Capacity

Richard J. Traverso, Reg. No. 30,595
Representative Capacity

Please forward correspondence to:

Douglas S. Foote, Law Vice President
NCR
Intellectual Property Section, Law Department
1700 South Patterson Blvd., WHQ5E
Dayton, Ohio 45479-0001

Attorney Docket No.: 9059.00/NCRCO-96X

Date: August 18, 2003

RJT:jqs
K:\Ncrco\96x\REPLY 8-18-03.doc